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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,407

05/15/2006

Steffen Junghanns

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EXAMINER

WANG-HURST, KATHY W

ART UNIT

PAPER NUMBER

4173

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,407	Applicant(s) JUNGHANNS ET AL.	
	Examiner KATHY WANG-HURST	Art Unit 4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/15/2006 and 12/31/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary amendment dated 5/15/2006 has been entered. Claims 1-15 are cancelled and claim 16-30 are pending for examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-30 are rejected under 35 U.S.C. 102(e) as being anticipated by **Witzel (US 2007/0171841)**.

Regarding claim 16, Witzel discloses a method for establishing a transcoder-free operation connection between two communication terminals in a communication network, comprising:

checking in a radio network controller (**[0116] access starting from a radio network controller**), upon receipt of a request from a switching unit relating to use of at least one subset of at least one codec mode configuration for establishment of a transcoder-free operation connection (**[0117] first originating network node e.g. a mobile switching center generates an initial supported codec list**), whether the at least one

requested subset is supported by the radio network controller **([0117] determine supported codecs)**;

establishing a transcoder-free operation connection to the switching unit and a communication terminal **([0117] TFO-TrFO harmonization is the first step to establish a transcoder-free operation)**, if the at least one subset of the at least one codec mode configuration is supported by the radio network controller **([0117] determine supported codecs)**; and

signaling, from the radio network controller to the communication terminal, at least one message relating to the subset of the at least one codec mode configuration to be used for transmission of data **([0121] the originating or terminating leg will be informed of decided codecs, therefore signaling from network to mobile terminal)**.

Regarding claim 17, Witzel discloses a method according to claim 16, wherein at least a part of at least one message relating to the at least one codec mode configuration to be used with at least two codec modes is signaled from the radio network controller to the communication terminal for the transmission of data in an uplink direction **([0117] and fig. 7 items 46, 40, 45 and 47, from mobile station to network controller therefore uplink direction)**.

Regarding claim 18, Witzel discloses a method according to claim 17, further comprising signaling from the radio network controller to the communication terminal at least a further part of at least one message relating to the at least one subset of the at

least one codec mode configuration to be used for the transmission of data in the uplink direction **([0117])**.

Regarding claim 19, Witzel discloses a method according to claim 18, wherein the radio network controller supports all subsets of a supported codec mode configuration **([0042])**.

Regarding claim 20, Witzel discloses a method according to claim 19, wherein the transcoder-free operation connection is established from the radio network controller to the communication terminal using a codec mode configuration supported by the radio network controller **([0042])**.

Regarding claim 21, Witzel discloses a method according to claim 20, wherein the codec mode configuration represents a combination of at least two codec modes **(Fig. 3 at least two codec modes)**.

Regarding claim 22, Witzel discloses a method according to claim 21, wherein the communication network is a cellular mobile radio network **(Fig. 1)**.

Regarding claim 23, Witzel discloses a method according to claim 22, wherein a radio resource control signaling is used by the radio network controller for signaling to the communication terminal **(Abstract)**.

Regarding claim 24, Witzel discloses a method according to claim 23, wherein a mobile radio terminal, mobile computer and/or mobile organizer is used as the communication terminal **(Abstract)**.

Regarding claim 25, Witzel discloses a radio network controller for establishing a transcoder-free operation connection between two communication terminals in a communication network having a switching unit and mobile network units, comprising: send and receive units communicating with the mobile network units **([0117] mobile terminals therefore have send and receive units communicating with mobile network uits)**; and at least one processing unit checking a request sent from the switching unit relating to use of a subset of a codec mode configuration for establishment of a transcoder-free operation connection to determine whether the requested subset is supported by the radio network controller **([0117] a list of codecs is generated and direct codecs are determined, therefore at least one processing unit)**, establishing a transcoder-free operation connection to the switching unit if the subset of the codec mode configuration is supported by said radio network controller **([0117] harmonization process is the first step to establish transcoder-free operation)**, and signaling a message relating to the subset of the codec mode configuration to be used for the transmission of data via said send unit to a communication terminal included among the mobile network units **([0121] the originating or terminating node will be informed of the decided codec)**.

Regarding claim 26, Witzel discloses a radio network controller according to claim 25, wherein said radio network controller signals at least a part of at least one message relating to the codec mode configuration to be used with at least two codec modes for the transmission of data in an uplink direction to the communication terminal **([0117])**.

Regarding claim 27, Witzel discloses a radio network controller according to claim 26, wherein said radio network controller signals at least a further part of at least one message relating to the at least one subset of the codec mode configuration to be used for the transmission of data in the uplink direction to the communication terminal **([0117] and Fig. 7)**.

Regarding claim 28, Witzel discloses a radio network controller according to claim 27, wherein the communication network is a cellular mobile radio network **(Abstract)**.

Regarding claim 29, Witzel discloses a radio network controller according to claim 28, wherein the mobile network units include at least one of a mobile radio terminal, a mobile computer and a mobile organizer **(Abstract)**.

Regarding claim 30, Witzel discloses a device according to claim 29, wherein the codec mode configuration is a combination of at least two codec modes **([0117])**.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ante Burilovic, Alen Bulic and Branko Mikac, "Introduction of Transcoder Free Operation into Core Network", June 11-13, 2003, 7th International Conference on Telecommunications, Zagreb, Croatia.

Hellwig (US 2004/0100914) discloses a method for a connection through a core network.

Graf (US 2003/0195981) discloses a method and node for the control of a connection in a communication network.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHY WANG-HURST whose telephone number is (571)270-5371. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHY WANG-HURST/
Examiner, Art Unit 4173

/Benny Q Tieu/
Supervisory Patent Examiner, Art Unit 4173